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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHEL CHEVANNE, PHILIPPE DRUGMAND and
PATRICK BERGEOT

Appeal 2009-011457
Application 10/697,125
Technology Center 2400

Before KRISTEN L. DROESCH, JEFFREY S. SMITH and
JASON V. MORGAN, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM and enter new grounds of rejection

BACKGROUND

The invention relates to the control of the integration of new network equipment or new versions of network equipment by a network management system. Spec. 1, ll. 12-16.

Claims 1 and 11 are illustrative and are reproduced below [indentation added]:

1. A device for controlling equipment management data in a communications network comprising a network management system capable of managing said equipment management data using previously loaded management data modules, associated with said equipment management data and stored in a memory, said device comprising

control means which when there is a request by said network management system to take over at least one new item of equipment management data in said communications network, extracts from said memory the management data module associated with said at least one new item of equipment, and then loads into said network management system each new management data module extracted, dynamically, so that the management by said network management system of said equipment management data in said communications network is not interrupted.

11. A method of controlling equipment management data in a communications network, in which network equipment is managed using loaded management data modules, associated with said network equipment, wherein,

in the case of a request to take over at least one new item of equipment in said communications network, new management data module associated with said at least one new

item of equipment is loaded dynamically so that management of other network equipment in said communications network is not interrupted.

The Examiner rejected claims 1, 5-11 and 15 under 35 U.S.C. § 102(b) as anticipated by Gandhi (U.S. 2005/0267935 A1).

The Examiner rejected claims 2-4, 12-14 and 16-20 under 35 U.S.C. § 103(a) as unpatentable over Gandhi and Chobotaro (U.S. 2003/0202408 A1).

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Gandhi, Chobotaro and Bowman-Amuah (U.S. 6,611,867 B1).

ISSUE

Did the Examiner err in finding that Gandhi describes the claimed invention?

Did the Examiner err in determining that the combination of Gandhi and Chobotaro and the combination of Gandhi, Chobotaro and Bowman-Amuah render obvious the claimed invention?

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellants' arguments in the Appeal Brief presented in response to the Final Office Action ("FOA") and the arguments in the Reply Brief presented in response to the Examiner's Answer.

Claims 11-12 and 16-20

Appellants argue that claims 11-12, and 16-20 are patentable over the prior art for the same reasons as claim 1. App. Br. 15, 18; Reply Br. 11. Appellants' arguments addressing claim 1 assert that Gandhi does not teach

or suggest a memory which stores loaded data management modules. App. Br. 13. Appellants' arguments addressing claim 1 are unpersuasive with respect to claim 11 because they are not commensurate in scope with the limitations of claim 11. Claim 11 does not recite a memory.

The Examiner finds that: (1) Gandhi's description documents correspond to the claimed management data modules (Ans. 4 (citing Gandhi ¶ 184)); and (2) Gandhi's description of dynamic detection corresponds to the claimed dynamic loading of new management data modules (Ans. 4 (citing Gandhi ¶ 568)). We are unpersuaded by Appellants' argument that Gandhi makes no disclosure of the relation between the description documents and dynamic detection. App. Br. 14. Gandhi describes that a description document is a structured unit of data that is used to learn the capabilities of a controlled device and which adheres to XML (extensible markup language) grammar. ¶ 75. Gandhi further describes that UPnP (Universal Plug and Play) devices support automatic discovery, identification and configuration. ¶ 567, 569. When using UPnP with configured networks (compared with ad-hoc networks) the dynamic detection (i.e., automatic discovery, identification and configuration) allows an operating system to immediately begin using added devices or stop using removed devices without rebooting. ¶ 568. During automatic discovery, a device description in XML format which provides a description of services and capabilities of the embedded computing device is downloaded to clients that access the device to allow activation of the device functionality from the client. ¶ 573. Since Gandhi teaches that description documents in XML format setting forth the services and capabilities of the device are downloaded during the automatic discovery aspect of dynamic detection,

contrary to Appellants' arguments Gandhi describes the relationship between the description document (i.e., a new management data module) and the dynamic detection (i.e., automatic discovery, identification and configuration).

Appellants present various arguments for the first time in the Reply Brief directed to the “previously loaded data management data modules”, “control means” and “request by the said network management system” limitations recited in claim 1. Reply Br. 6-10. Appellants' arguments are not presented in Response to the Examiner's Answer and could have been raised in the Appeal Brief. *Compare* Ans. 3-4, 14-17 *with* FOA 2-3. Since the arguments in the Reply Brief could have been presented in the Appeal Brief to rebut the rejections made in the Final Office Action, Appellants' arguments are waived and are not considered. *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative decision) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”). We further note that Appellants' newly presented arguments addressing the limitations of claim 1 are not commensurate in scope with the claim limitations since claim 11 does not recite “previously loaded data management data modules”, “control means” or “a request by the said network management system”.

For all these reasons, we sustain the rejection of claims 11 as anticipated by Gandhi and sustain the rejection of claims 12 and 16-20 as obvious over Gandhi and Chobotaro.

Claim 15

Appellants argue that claim 15, which depends from claim 11, is patentable over the prior art for the same reasons as claim 5, which depends from claim 1. App. Br. 15. Appellants' arguments addressing claim 5 emphasize that Gandhi does not teach loading of management data modules according to at least a first mode and second mode as recited in claim 5. App. Br. 14-15; Reply Br. 11. Appellants' arguments addressing claim 5 are unpersuasive with respect to claim 15 because they are not commensurate in scope with the limitations of claim 15. Claim 15 does not recite a first mode and a second mode.

For these reasons, in addition to those explained before addressing claims 11-12 and 16-20, we sustain the rejection of claim 15 as anticipated by Gandhi.

Claim 13

Appellants argue that claim 13, which depends from claim 11, is patentable over the prior art for the same reasons as claim 3, which depends from claim 1. App. Br. 19. Appellants argue that contrary to the Examiner's findings (Ans. 9-10; FOA 7-8), Figure 2 of Gandhi does not teach or suggest a remote controller 204, a user interface or a controlled device 206. App. Br. 17.

We are unpersuaded by Appellants' arguments. Gandhi's Figure 2 depicts user control points 104, 105 and controlled devices 106, 107. Gandhi ¶ 127. Gandhi further discloses that the user control points 106, 107 include user interfaces. Gandhi ¶ 130.

Appellants also argue that Gandhi's controlled device 106 fails to teach or suggest "wherein said standby consists firstly of allowing the

management of said new version of the equipment from said new management data module, without taking account of error messages related to its non-integration in said communications network” as recited in claim 3. App. Br. 17. Appellants still further argue that Gandhi’s teaching at paragraph 48 cited by the Examiner fails to teach or suggest “to send a message to said old management data module indicating that a change of version is under way and that said old management data module must not take account of at least some of the error messages related to a conjoint management of the old and new versions of the equipment” as recited in claim 3. App. Br. 17.

Appellants’ arguments are unpersuasive as they merely reiterate the disputed claim limitations and make general allegations that Gandhi does not teach the disputed limitations. Merely reciting the language of the claims and asserting that the cited prior art references do not disclose each claim limitation is insufficient. *See* 37 C.F.R. § 41.37(c)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

Appellants also present various arguments for the first time in the Reply Brief directed to the “standby” and “error messages” limitations

recited in claim 3 and providing additional reasons why Gandhi's paragraph 48 does not teach or suggest the disputed limitations. Reply Br. 13-14.

Appellants' arguments are not presented in Response to the Answer and could have been raised in the Appeal Brief. *Compare* Ans. 9-10, 19-20 with FOA 8-9. Since the arguments in the Reply Brief could have been presented in the Appeal Brief to rebut the rejections made in the Final Office Action, Appellants' arguments are waived and are not considered. *Borden*, 93 USPQ2d at 1474.

For all these reasons, in addition to those explained before addressing claims 11-12 and 16-20, we sustain the rejection of claim 13 as obvious over Gandhi and Chobotaro.

Claim 14

Appellants argue that claim 14, which depends from claim 11, is patentable over the prior art for the same reasons as claim 4, which depends from claim 1. App. Br. 19. Appellants argue that Chobotaro does not teach or suggest the features of claim 1 which are missing from Gandhi and therefore claim 14 is patentable for the same reasons as claim 1. App. Br. 19.

Appellants' arguments are unpersuasive because as explained before, the limitations of claim 11 are of different scope than the limitations of claim 1. As to Appellants' arguments addressing claim 1 that are pertinent to claim 11, as explained before we are unpersuaded that Gandhi fails to teach the limitations of claim 11. Moreover, Appellants' arguments do not meaningfully explain why Chobotaro fails to remedy the supposed deficiencies of Gandhi with respect to claim 11.

Appellants also argue that one with ordinary skill in the art at the time of the invention would not have been motivated to combine Gandhi and

Chobotaro as suggested by the Examiner because there is no suggestion or motivation for doing so in the references themselves or the knowledge available to one with ordinary skill in the art without resorting to impermissible hindsight. App. Br. 18. Appellants further argue that Gandhi and Chobotaro teach fundamentally different systems because Gandhi relates to networking multiple devices and Chobotaro relates to device drivers of a single device. *Id.*

Appellants' arguments are unpersuasive because it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Appellants' arguments also narrowly focus on the differences between Gandhi and Chobotaro, suggesting that one with ordinary skill in the art would not know how to combine the teachings of Chobotaro's single device with Gandhi's multiple networked devices.

"Common sense teaches [] that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421. We further recognize that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but is proper so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Appellants do not meaningfully explain how the determination of

obviousness is based upon knowledge gleaned from Appellants' Specification.

Appellants argue for the first time in the Reply Brief that Chobotaro's description in Figure 3, reference 305 does not teach or suggest every element of claim 1 missing from Gandhi. Reply Br. 15. Appellants' arguments are not presented in Response to the Answer and could have been raised in the Appeal Brief. *Compare* Ans. 11, 20-21 *with* FOA 10. Since the arguments in the Reply Brief could have been presented in the Appeal Brief to rebut the rejections made in the Final Office Action, Appellants' arguments are waived and are not considered. *Borden*, 93 USPQ2d at 1474.

For all these reasons, in addition to those explained before addressing claims 11-12 and 16-20, we sustain the rejection of claim 14 as obvious over Gandhi and Chobotaro.

Claim 21

Appellants argue that claim 21, which depends from claim 11 is patentable because Chobotaro and Bowman-Amuah do not remedy the deficiencies of Gandhi. App. Br. 19. Appellants' arguments do not meaningfully explain why Chobotaro and Bowman-Amuah fail to remedy the supposed deficiencies of Gandhi with respect to claim 11. As explained before with respect to claim 11, we are unpersuaded that Gandhi fails to teach the limitations of claim 11.

Appellants also for the first time in the Reply Brief argue that column 7, lines 35-60 and Figure 51 of Bowman-Amuah do not teach or suggest the features of claim 11 which are missing from Gandhi. Reply Br. 16. Appellants' arguments are not presented in Response to the Answer and could have been raised in the Appeal Brief. *Compare* Ans. 13-14, 21 *with*

FOA 12-13. Since the arguments in the Reply Brief could have been presented in the Appeal Brief to rebut the rejections made in the Final Office Action, Appellants' arguments are waived and are not considered. *Borden*, 93 USPQ2d at 1474.

For all these reasons, in addition to those explained before addressing claims 11-12 and 16-20, we sustain the rejection of claim 21 as obvious over Gandhi, Chobotaro and Bowman-Amuah.

NEW GROUNDS OF REJECTION

We enter a new ground of rejection of claims 1-10 under 35 U.S.C. § 112, 2nd paragraph because the claims are rendered indefinite by the claim recitation of:

control means which when there is a request by said network management system to take over at least one new item of equipment management data in said communications network, extracts from said memory the management data module associated with said at least one new item of equipment, and then loads into said network management system each new management data module extracted, dynamically, so that the management by said network management system of said equipment management data in said communications network is not interrupted.

The aforementioned claim recitation describes a function without a structure. Since claim 1 does not utilize the term “means for”, we presume that Appellants did not intend to invoke 35 U.S.C. § 112, 6th paragraph. Moreover, Appellants do not identify the “control means” as a means-plus-function limitation permitted by 35 U.S.C. §112, 6th paragraph in accordance with 37 C.F. R. § 41.37 (c)(1)(v). App. Br. 6. The “control means” recited in claim 1 is set forth in purely functional terms (i.e., extracting, loading, etc.) and does not describe a structure. The scope of claim 1 is indefinite because

one with ordinary skill in the art would not be able to ascertain the structure that is intended to be encompassed by the claim. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1212-13 (2008) (precedential); *Halliburton Energy Services v. M-ILLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008); *Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C 112 and for Treatment of Related Issues in Patent Applications*, 76 F.R. 7162 (Feb. 9, 2011). For example, it is unclear from the claim language whether the “control means” corresponds to a software program embedded on a computer readable medium and operable on a general purpose computer, or whether it corresponds to a special purpose processor. We further note that Appellants’ Specification does not offer any meaningful enlightenment. Appellants direct attention to the control module described at page 10, lines 14-15 for written description support for the claimed control means. App. Br. 6. The remainder of Appellants’ Specification does not set forth a particular structure for the control module, with the exception of depicting a box 10 as part of the control device 1 in the Figure.

Additionally, the claim recitation “a request by said network management system to take over at least one new item of equipment management data” renders claims 1-10 indefinite. For example, it is unclear whether “to take over . . . equipment management data” means to control the equipment management data or to acquire or obtain the equipment management data.

We also enter a new ground of rejection of claims 1-10 under 35 U.S.C. § 112, 1st paragraph because the written description does not enable the full scope of the claims. Since the aforementioned “control means” limitation is purely functional (i.e., extracting loading, etc.), any and all

means of performing the function may be encompassed by the claim. *See Miyazaki*, 89 USPQ2d at 1215-1217; 76 F.R. 7162. Appellants' Specification does not provide sufficient description under 35 U.S.C. § 112, 1st paragraph to enable any and all means for performing the functions of extracting the management data module associated with the at least one new item of equipment from the memory and dynamically loading each new extracted management data module into the network management system so that the management by the network management system of the equipment management data in the communications network is not interrupted.

We do not reach the Examiner's rejections of claims 1-10 over the prior art. In light of the new grounds of rejection of claims 1-10 under 35 U.S.C. § 112, 1st paragraph and 2nd paragraph, and the positions taken by the Examiner and Appellants with respect to that rejection, we exercise our discretion to not address the rejections over the prior art. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

DECISION

We AFFIRM the rejection of claims 11 and 15 under 35 U.S.C. § 102(b) as anticipated by Gandhi.

We AFFIRM the rejection of claims 12-14 and 16-20 under 35 U.S.C. § 103(a) as unpatentable over Gandhi and Chobotaro

We AFFIRM the rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Gandhi, Chobotaro and Bowman-Amuah

We enter a new grounds of rejection of claims 1-10 under 35 U.S.C. § 112, first paragraph.

We enter a new grounds of rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph.

TIME PERIOD

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

msc